

## **REMARKS**

In response to the above-identified Final Office Action ("Action"), Applicant traverses the Patent Office's rejection to the claims and seeks reconsideration thereof. Claims 1-23 are now pending in the present Application. Claims 14-18 are withdrawn. In this response, claims 1 and 19 are amended and no claims have been cancelled.

### **I. Examiner Interview Summary**

Applicant and attorney of record James Thein conducted an in person Examiner Interview with Examiner Robyn K. Doan on October 16, 2006. During the interview amendments to claims 1 and 19 were discussed as well as various prior art references. During the interview the Examiner indicated that the claims may be in condition for allowance if amended as suggested by the Examiner. Subsequent to the in person interview, Applicant's attorney Stacie J. Sundquist forwarded to the Examiner proposed amendments to the claims, specification and Figure 1A for the Examiner's review. On October 20, 2006 during a telephone conversation with Stacie J. Sundquist, the Examiner indicated she believed the amendments submitted herewith place the claims in condition for allowance.

### **II. Claim Amendments**

Applicant respectfully submits herewith amendments to claims 1 and 19. Claim 1 is amended to recite the elements of "a generally peripheral member conformable to a substantially horseshoe shape with a heel having a first end defined by a first point and a second end defined by a different second point and sized to be worn on less than an entire portion of a scalp of a human head and enclose an occipital portion and a parietal portion of the human head" and "wherein, when the peripheral member is worn on a head of a wearer in such a manner to enclose the occipital portion and the parietal portion, the longitudinal member extends laterally between ears of the wearer, and the plurality of diagonal members divide the first portion and the second portion into a plurality of geometric regions, the geometric regions of the second portion to overlay the occipital portion and one of the plurality of diagonal members dividing the second portion is coupled to the first point of the peripheral member and at least another of the plurality

of diagonal members is coupled to the second point, each of the geometric regions of a dimension suitable to allow natural hair of a wearer of the foundation to be drawn through the geometric regions.” Support for the amendment may be found, for example, in the amendments to paragraphs [0024] and [0026] of the specification submitted herewith, amended Figure 1A, and Figures 5-8 of the Application.

Claim 19 is amended to recite the method comprising “coupling a device of claim 1 to an individual wearer’s hair.”

In view of the foregoing, the amendments are supported by the specification and do not add new matter. Applicant respectfully requests consideration and entry of the amendments to claims 1 and 19.

### **III. Drawing Amendment**

Applicant respectfully submits herewith amendments to Figure 1A to include reference numbers “124”, “125-1” and “125-2” corresponding to elements recited in the amendments to claim 1, namely the “heel”, “first point” and “second point”, respectively. The amended drawing sheet is identified as “Replacement Sheet” and a marked up copy of the original Figure 1A is further included and labeled as “Annotated Sheet” pursuant to 37 CFR 1.121(d). Applicant respectfully requests consideration and entry of the amendment to Figure 1A.

### **IV. Claim Rejections – 35 U.S.C. §102**

In the outstanding Action, claims 1, 4-9, 13 and 19-23 are rejected under 35 U.S.C. §102(b) as being anticipated by, U. S. Patent No. 3,645,279 issued to Imre (“Imre”).

It is axiomatic to a finding of anticipation that a reference teach each and every element of the claims. In regard to claim 1, Applicant respectfully submits Imre fails to teach or suggest at least the elements of “a generally peripheral member conformable to a substantially horseshoe shape with a heel having a first end defined by a first point and a second end defined by a different second point and sized to be worn on less than an entire portion of a scalp of a human

head and enclose an occipital portion and a parietal portion of the human head” and “wherein, when the peripheral member is worn on a head of a wearer in such a manner to enclose the occipital portion and the parietal portion, the longitudinal member extends laterally between ears of the wearer, and the plurality of diagonal members divide the first portion and the second portion into a plurality of geometric regions, the geometric regions of the second portion to overlay the occipital portion and one of the plurality of diagonal members dividing the second portion is coupled to the first point of the peripheral member and at least another of the plurality of diagonal members is coupled to the second point, each of the geometric regions of a dimension suitable to allow natural hair of a wearer of the foundation to be drawn through the geometric regions” as recited in amended claim 1. The Patent Office has not pointed to, and Applicant is unable to discern, a portion of Imre teaching each of these elements. Since each and every element of claim 1 is not found within the reference, anticipation may not be established. For the foregoing reasons, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 1 under 35 U.S.C. §102(b).

In regard to claim 19, claim 19 is amended to recite a method comprising “coupling a device of claim 1 to an individual wearer’s head.” Thus, for at least the reasons that Imre fails to teach each and every element of claim 1, Imre further fails to teach each of the elements of claim 19. Since each and every element of claim 19 is not taught by Imre, anticipation may not be found. For the foregoing reasons, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 19 under 35 U.S.C. §102(b).

In regard to claims 4-9, 13 and 20-23, claims 1-9 and 13 depend from claim 1 and claims 20-23 depend from claim 19 and incorporate the limitations thereof. Thus, for at least the reasons discussed in regard to claims 1 and 19, Imre fails to teach each and every element of claims 4-9, 13 and 20-23. Since each and every element of the claims is not taught by Imre, anticipation may not be found. For the foregoing reasons, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 4-9, 13 and 20-23 under 35 U.S.C. §102(b).

**V. Claim Rejections – 35 U.S.C. §103(a)**

A. In the outstanding Action, claim 2 is rejected under 35 U.S.C. §103(a) as being unpatentable over Imre in view of U. S. Patent No. 3,628,546 issued to Ensminger ("Ensminger"). Applicant respectfully traverses the rejections.

To establish a *prima facie* case of obviousness, the Patent Office must show that the cited reference teaches or suggests each of the elements of a claim. Hindsight reconstruction may not be used to modify the reference to meet the claimed invention. MPEP §2145. Furthermore, the fact that the claimed invention is within the capabilities of one of ordinary skill in the art, without some showing of an objective reason for modifying the reference to arrive at the claimed invention, is not sufficient to establish a *prima facie* case of obviousness. *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000).

In regard to claim 2, claim 2 depends from claim 1 and incorporates the limitations thereof. Thus, for at least the reasons discussed in the traversal of claim 1 over Imre, Imre fails to teach or suggest at least the elements of "a generally peripheral member conformable to a substantially horseshoe shape with a heel having a first end defined by a first point and a second end defined by a different second point and sized to be worn on less than an entire portion of a scalp of a human head and enclose an occipital portion and a parietal portion of the human head" and "wherein, when the peripheral member is worn on a head of a wearer in such a manner to enclose the occipital portion and the parietal portion, the longitudinal member extends laterally between ears of the wearer, and the plurality of diagonal members divide the first portion and the second portion into a plurality of geometric regions, the geometric regions of the second portion to overlay the occipital portion and one of the plurality of diagonal members dividing the second portion is coupled to the first point of the peripheral member and at least another of the plurality of diagonal members is coupled to the second point, each of the geometric regions of a dimension suitable to allow natural hair of a wearer of the foundation to be drawn through the geometric regions" as incorporated into claim 2. Moreover, the Patent Office has not pointed to and Applicant is unable to discern a portion of Ensminger curing the deficiencies of claim 2 with respect to these elements.

Applicant further submits there is no motivation to combine Imre with Ensminger to teach the element of “the peripheral member comprises a wire” as further recited in claim 2. Ensminger discloses an undulated wire strip to form hairpieces such as wiglets which covers only a minimal amount of scalp and hair of the wearer. See Ensminger, col. 1, lines 36-50, col. 2, lines 24-25. The Patent Office alleges it would have been obvious to one of ordinary skill in the art to incorporate the undulated wire frame 10 of Ensminger into the device of Imre to enhance durability and flexibility to the device. See Action, page 6. Applicant respectfully submits, it is unclear how a wire bent back and forth on itself to form a planar band as shown in Ensminger may be incorporated into the elliptical base member of Imre which is designed to cover the user’s entire head. In any case, Imre teaches away from such a modification. Imre discloses a full wig having a base which resiliently engages and encircles the user’s head. See Imre, Figs. 1-6. Imre further teaches that a disadvantage of the prior art wigs is that their bases are not sufficiently elastic to obtain a comfortable fit. See Imre, col. 1, lines 17-23. Clearly, replacing the base of Imre with a wire base would not allow the wig of Imre to achieve the desired comfortable fit. Based on the foregoing teachings of Imre, one of ordinary skill in the art would not be motivated to replace the resilient elliptical base of Imre which achieves a comfortable fit with a wire member that prevents such a fit. Thus, for at least the foregoing reasons, there is no motivation to combine Imre and Ensminger in the manner relied upon by the Patent Office.

Thus, for at least the foregoing reasons, neither Imre nor Ensminger, alone or in combination, may be relied upon to teach each and every element of claim 2. Since the references fail to teach or suggest each and every element of claim 2, a *prima facie* case of obviousness may not be found. For the foregoing reasons, Applicant respectfully requests withdrawal of the rejection of claim 2 under 35 U.S.C. §103.

**B.** In the outstanding Action, claim 3 is rejected under 35 U.S.C. §103(a) as being unpatentable over Imre in view of U. S. Patent No. 5,873,373 issued to Narvick (“Narvick”). Applicant respectfully traverses the rejections.

In regard to claim 3, claim 3 depends from claim 1 and incorporates the limitations thereof. Thus, for at least the reasons discussed in the traversal of claim 1 over Imre, Imre fails

to teach or suggest at least the elements of “a generally peripheral member conformable to a substantially horseshoe shape with a heel having a first end defined by a first point and a second end defined by a different second point and sized to be worn on less than an entire portion of a scalp of a human head and enclose an occipital portion and a parietal portion of the human head” and “wherein, when the peripheral member is worn on a head of a wearer in such a manner to enclose the occipital portion and the parietal portion, the longitudinal member extends laterally between ears of the wearer, and the plurality of diagonal members divide the first portion and the second portion into a plurality of geometric regions, the geometric regions of the second portion to overlay the occipital portion and one of the plurality of diagonal members dividing the second portion is coupled to the first point of the peripheral member and at least another of the plurality of diagonal members is coupled to the second point, each of the geometric regions of a dimension suitable to allow natural hair of a wearer of the foundation to be drawn through the geometric regions” as incorporated into claim 3. Moreover, the Patent Office has not pointed to and Applicant is unable to discern a portion of Narvick curing the deficiencies of claim 3 with respect to these elements. Thus, for at least the foregoing reasons, neither Imre nor Narvick, alone or in combination, may be relied upon to teach each and every element of claim 3. Since the references fail to teach or suggest each and every element of claim 3, a *prima facie* case of obviousness may not be found. For the foregoing reasons, Applicant respectfully requests withdrawal of the rejection of claim 3 under 35 U.S.C. §103.

C. In the outstanding Action, claims 10-12 are rejected under 35 U.S.C. §103(a) as being unpatentable over Imre in view of U. S. Patent No. 3,435,832 issued to Yonezo Ito (“Yonezo”). Applicant respectfully traverses the rejections.

Claims 10-12 depend from claim 1 and incorporates the limitations thereof. Thus, for at least the reasons discussed in regard to claim 1, Imre fails to teach or suggest at least the elements of “a generally peripheral member conformable to a substantially horseshoe shape with a heel having a first end defined by a first point and a second end defined by a different second point and sized to be worn on less than an entire portion of a scalp of a human head and enclose an occipital portion and a parietal portion of the human head” and “wherein, when the peripheral

member is worn on a head of a wearer in such a manner to enclose the occipital portion and the parietal portion, the longitudinal member extends laterally between ears of the wearer, and the plurality of diagonal members divide the first portion and the second portion into a plurality of geometric regions, the geometric regions of the second portion to overlay the occipital portion and one of the plurality of diagonal members dividing the second portion is coupled to the first point of the peripheral member and at least another of the plurality of diagonal members is coupled to the second point, each of the geometric regions of a dimension suitable to allow natural hair of a wearer of the foundation to be drawn through the geometric regions” as found in claims 10-12. Moreover, the Patent Office has not pointed to and Applicant is unable to discern a portion of Yonezo curing the deficiencies of Imre with respect to these elements. Thus, for at least the foregoing reasons, neither Imre nor Yonezo, alone or in combination, may be relied upon to teach each and every element of claims 10-12. Since the references fail to teach or suggest each and every element of claims 10-12, a *prima facie* case of obviousness may not be found. For the foregoing reasons, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 10-12 under 35 U.S.C. §103.

### CONCLUSION

In view of the foregoing, it is believed that all claims now pending are in condition for allowance and such action is earnestly solicited at the earliest possible date. If there are any additional fees due in connection with the filing of this response, please charge those fees to our Deposit Account No. 02-2666. Questions regarding this matter should be directed to the undersigned at (310) 207-3800.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR, & ZAFMAN LLP

Dated: October 20, 2006

By: Stacie J. Sundquist  
Stacie J. Sundquist, Reg. No. 53,654

12400 Wilshire Blvd.  
Seventh Floor  
Los Angeles, California  
90025  
(310) 207-3800

### CERTIFICATE OF TRANSMISSION:

I hereby certify that this correspondence is being transmitted electronically to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on October 20, 2006.

Si Vuong

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